

REMARKS

Claims 10 and 27 are amended to correct grammar and antecedent basis.

Claims 9 and 27 are amended. Support for the amendments may be found, for example, in the specification at the abstract, [0027], [0028], [0037] and [0040].

Claims 1-31 are pending in this application.

Claim Rejections Under 35 USC §103(a)

King and Soufi:

Claims 9, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *King et al.*, US Publication No. 2002/0087868 (hereinafter, “King”) in view of Quorum Consensus Protocol Tailored for the Client/Server Architecture, Soufi; (October, 1993) (hereinafter “Soufi”). Applicants respectfully submit the amendments to claims 9, 27 and 29 overcome the rejection for at least the following reasons.

Summary of King:

King is generally directed to a portable storage device, such as a smart card, having thereon network identification and configuration data for a processing unit in a communication network. If the processing unit fails, King’s smart card may be inserted into and read by a replacement processing unit. The replacement processing unit may read the network identity and configuration of the failed processing unit from the smart card, and incorporate the network identity and the configuration of the failed processing unit so as to appear to the communication network as a working version of the failed processing unit.

Summary of the present application:

The present application is generally directed to a portable media device having thereon network settings for an ad hoc peer to peer network. The portable media device maybe inserted into various devices that wish to join the ad hoc peer to peer network, and the various devices may automatically configure for joining the ad hoc peer to peer network by

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

using the network settings contained in the portable media device. Upon completion of configuration, the various devices may write a configuration log onto the portable media device.

Claim 9:

Claim 9 is amended in response to the Office Action. Applicants respectfully submit a *prima facie* case of obviousness for amended claim 9 cannot be established by King and Soufi as each and every element of amended claim 9 is not found in a combination of King and Soufi. For example, the Office Action, page 3 cited to King [0064], lines 1-11 as teaching the element “the portable media device having data stored thereon comprising an XML file containing peer to peer network settings for setting up the computing device to join an ad hoc peer to peer wireless network when the portable media device is connected to the computing device...” Applicants respectfully disagree for at least the following reasons.

Peer to Peer Network Settings for the Ad Hoc Peer to Peer Wireless Network on the Portable Media Device:

Applicants respectfully submit King does not teach “A portable media device ... comprising an XML file containing peer to peer network settings ... the peer to peer network settings for the ad hoc peer to peer wireless network,” as required by amended claim 9. The Office Action, page 5 cited to King [0064], lines 1-11 as teaching this element. King [0064] describes his smart card as containing a network identity and configuration data. Unlike claim 9, though, the network identity and the configuration data contained on King’s smart card are the network identity and configuration data **specific to the processing unit:** “The portable storage device includes storage... The storage holds a network identity and configuration information **for the processing unit...**” (King, abstract.). In fact, King [0046] describes how the network identity and the configuration are particular to a computing device and not particular to the network:

In order to communicate via the network, the processing unit 22 needs to have a network identity that can be recognised by other devices on the network. Also, the processing unit 22 will have associated with it certain parameters that define aspects of the system configuration including system configuration

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

information, or configuration data, describing the state of the software installed on the hard disk relative to the initial state of that software.

In particular, the network identity and the configuration data of King [0064] is the information that the new, replacement entity will incorporate as its own identity and configuration in order to represent itself as a working version of the specific failed unit to the rest of the network.

The “peer to peer network settings” recited by claim 9, however, are not for the computing device as taught by King, but instead are “for the ad hoc peer to peer wireless network.” For example, on the portable media device, rather than storing the network identity by which the failed computing device was known to the network as in King, the name of the actual peer to peer network may be stored (specification, [0048]). Other such examples of network (and not computing entity) level settings are described in [0043]-[0044] and Figure 8 of the specification. This distinction between King and the present application makes sense, as King is directed to configuring a replacement device or processor to appear as an identical replacement for a failed entity. Thus, King’s processor would only need to receive from the smart card the network identity and configuration data of the failed entity in order to present itself to the network as a working replacement of the failed entity (King, [0010]). King’s smart card would not need (and is not taught by King to contain) any network settings of the network itself, as all the replacement unit would require to simulate the failed entity is the specific network identity and configuration data of the failed entity.

Thus, for at least the above reasons, cited passage King [0064] does not teach the element of amended claim 9 “an XML file containing peer to peer network settings for setting up the computing device to join an ad hoc peer to peer wireless network when the portable media device is connected to the computing device, the peer to peer network settings for the ad hoc peer to peer wireless network.” Applicants submit Soufi also does not teach, disclose or suggest this element, nor was Soufi used for this purpose.

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

XML File:

With further regard to the element of claim 9 the element “the portable media device having data stored thereon comprising an XML file containing peer to peer network settings for setting up the computing device to join an ad hoc peer to peer wireless network when the portable media device is connected to the computing device...,” Applicants do not find in King [0064], lines 1-11 (or in any passage of King for that matter) a teaching of an XML file, let alone a teaching of an XML file containing peer to peer network settings. Use of the XML file format to contain peer to peer network settings as called for by amended claim 9 conveniently allows the peer to peer network settings to be recognized by and deliverable to many different devices. King’s smart card may only be inserted into computing devices that are fluent in the (potentially proprietary) format used by King’s smart card. By lacking an XML file format, King’s smart card cannot be as widely used as the portable media device of the present application. Indeed, King’s smart card does not need to be widely used across various devices. As a specific computing device that receives King’s smart card is configured to be an exact replacement for a specific failed unit, the exact file format recognizable by the replacement computing device may generally be known *a priori*, and there may be no need for a generally recognizable file format on the portable media device. Thus, King’s smart card does not have a need to be widely useable across many (potentially unknown) different types of computing devices, and does not teach an XML file on his smart card.

The Office Action did not cite to any passage of Soufi as teaching “an XML file...” nor was Soufi used for this purpose.

Configuration Log Files on the Portable Media Device:

Furthermore, Applicants respectfully submit that no combination of King and Soufi teaches, suggests or discloses the element of amended claim 9: “a plurality of configuration log files with each of the plurality configuration log files indicating peer to peer network settings provisioned onto a different computing device.” King merely teaches unprotected portions of his smart card to be generally writeable in the manner of a standard writeable removable storage medium (King, [0093]). King does not teach a provisioned

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

configuration of a specific computing device being logged into a file on the portable media device. Soufi also does not appear to teach, disclose or suggest this element.

This feature of logging provisioned configurations of multiple devices on the portable media device provides advantages over King. King is generally directed to providing a configuration to a replacement unit in a network via smart card when an original unit fails. King does not appear to teach generating any feedback or log indicating how the replacement unit was configured, let alone writing such feedback or log onto the portable media device. The present invention, however, provides this useful feature. The present invention is generally directed to helping a user automatically set up multiple computing devices in a wireless network. By allowing multiple computing devices to write, after provisioning, their own specific configuration logs on the portable media device, a user is enabled to conveniently retrieve the configuration logs for all provisioned devices from a single location (i.e., the portable media device), and may thus quickly and positively obtain feedback regarding which computing devices have been provisioned with which configuration settings. King simply does not provide this benefit.

Thus, for at least the above reasons, Applicants respectfully submit a *prima facie* case of obviousness cannot be established for amended claim 9 by King and Soufi. Therefore, amended claim 9 is allowable over King and Soufi under 35 U.S.C. §103(a).

Claims 27 and 29:

Independent claim 27 is amended in response to the Office Action. Applicants respectfully submit a *prima facie* case of obviousness for amended claim 27 cannot be established by King and Soufi as each and every element of amended independent claim 27 is not found in a combination of King and Soufi. For example, amended independent claim 27 recites features similar to amended claim 9, including, *inter alia*: “the portable media device containing peer to peer network settings for the ad hoc peer to peer wireless network” and “the peer to peer network settings contained in an XML file on the portable media device.”

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

For at least reasons similar to amended claim 9, Applicants submit a *prima facie* case of obviousness cannot be established for amended claim 27 by King and Soufi. Therefore, amended independent claim 27 is allowable over King and Soufi under 35 U.S.C. §103(a).

Claim 29 depends from amended independent claim 27, and therefore incorporates by reference each and every element of amended independent claim 27. Amended independent claim 27 has been shown to be allowable over King and Soufi. Applicants respectfully submit that for reasons similar to amended independent claim 27, dependent claim 29 is also allowable over King and Soufi.

Moreover, Applicants respectfully submit that the Office Action has not demonstrated that the limitations recited by claim 29 are taught in a combination of King and Soufi. For example, claim 29 recites, *inter alia*, “writing peer to peer network settings configured on the computing device into the portable media device.” Applicants did not find a citation anywhere in the Office Action to any passages of King or Soufi with regard to this limitation recited by claim 29. Accordingly, the Office Action has not demonstrated that each and every element of claim 29 is found in a combination of King and Soufi, and therefore has not established a *prima facie* case of obviousness for claim 29. Claim 29 is thus allowable over King and Soufi under 35 U.S.C. §103(a).

King and Cedola:

Claims 1-5, 8-10, 13-19, 22-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Cedola, US Publication No. 2004/0221298 (“Cedola”). Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness by King and Cedola for claims 1-5, 8-10, 13-19, 22-24 and 28 under 35 U.S.C. 103(a).

Claims 1-5, 8-10 and 13-19:

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

Applicants submit that Cedola is disqualified for use as a reference under 35 U.S.C. 103(a) as Cedola and the present application were subject to an obligation to the same assignee at the time of the present invention as per 35 U.S.C. §103(c)(1):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present invention was filed on March 23, 2004 and was subject to an assignment to Microsoft Corporation as recorded on March 23, 2004 at Reel/Frame number 015142/0367. Cedola was filed on May 2, 2003, and was subject to an assignment to Microsoft Corporation as recorded on May 2, 2003 at Reel/Frame number 014046/0764. Thus, as both the present application and Cedola were subject to an assignment to Microsoft Corporation as of the present application's filing date of March 23, 2004, Cedola is disqualified as a reference.

Accordingly, as Cedola is disqualified as a reference, and as the Office Action has not demonstrated a passage of King that teaches, discloses or suggests each and every element of claims 1-5, 8-10 and 13-19, Applicants respectfully submit the Office Action has not established a *prima facie* case of obviousness for claims 1-5, 8-10 and 13-19. Claims 1-5, 8-10 and 13-19 are thus allowable under 35 U.S.C. §103(a).

Claims 22-24:

Although the Office Action stated on page 4, item 6 that claim 22 is rejected under King and Cedola, the detailed remarks for claim 22 on page 11 of the Office Action did not refer to Cedola. Instead, the Office Action cited to King and Polcha et al., US Publication No. 2003/0217126 (hereinafter “Polcha”). Applicants will discuss claims 22-24 in a subsequent section along with other claims that were rejected using Polcha.

Claim 28:

Claim 28 was rejected under 35 U.S.C. §103(a) as unpatentable over King and Cedola. Claim 28 depends from independent claim 27 and therefore claim 28 incorporates by

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

reference each and every element of independent claim 27. As previously discussed, Cedola is disqualified as a reference, thus only King remains as an allegedly qualified reference. However, as previously discussed with regard to the alleged rejection of independent claim 27 as being unpatentable over King and Soufi, no combination of King and Soufi teaches, discloses or suggests each and every element of independent claim 27. Therefore, King alone does not teach, disclose or suggest each and every element of independent claim 27. Accordingly, as dependent claim 28 incorporates each and every element of independent claim 27, King also does not teach, disclose or suggest each and every element of dependent claim 28. Dependent claim 28 is thus allowable over King and Cedola under 35 U.S.C. §103(a).

King, Cedola and Polcha:

Claims 6, 7, 11, 12, 20, 21, 25, 26, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Cedola and further in view of Polcha. Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness by King, Cedola and Polcha for claims 6, 7, 11, 12, 20, 21, 25, 26, 30 and 31 under 35 U.S.C. 103(a). Applicants further submit the Office Action has not established a *prima facie* case of obviousness by King and Polcha for claims 22-24 under 35 U.S.C. 103(a), as will be discussed below.

Claims 6, 7, 11, 12, 20, 21:

For example, each of dependent claims 6, 7, 11, 12, 20, 21 depend from an independent claim for which the Office Action cited to King and Cedola, e.g. independent claims 1, 9 and 15. As previously discussed for claims 1, 9 and 15, Cedola is disqualified as a reference, and the Office Action did not cite to a passage of King that teaches, suggests or discloses each and every element of independent claims 1, 9 and 15. Furthermore, the Office Action did not cite to a passage of Polcha that teaches, suggests or discloses the missing elements of independent claims 1, 9 and 15, nor was Polcha used for this purpose. Thus, the Office Action has not demonstrated a combination of King and Polcha that teaches, discloses or suggests each and every element of independent claims 1, 9 and 15.

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

Dependent claims 6, 7, 11, 12, 20 and 21 incorporate by reference each and every element of the independent claim from which they depend and any intervening claims. The Office Action has not demonstrated a combination of King and Polcha that teaches, discloses or suggests each and every element of independent claims 1, 9 and 15, and therefore, the Office Action has not demonstrated a combination of King and Polcha that teaches, discloses or suggests each and every element of dependent claims 6, 7, 11, 12, 20, 21. Accordingly, Applicants submit the Office Action has not established a *prima facie* case of obviousness for dependent claims 6, 7, 11, 12, 20, 21 over King and Polcha, and dependent claims 6, 7, 11, 12, 20, 21 are allowable under 35 U.S.C. §103(a).

Claim 22:

The Office Action, page 11 only cited to passages of King and Polcha (but not Cedola) with respect to independent claim 22. Applicants respectfully submit the Office Action has not established a *prima facie* case of obviousness for claim 22 as the Office Action has not demonstrated that each and every element of claim 22 is found in a passage of King and Polcha.

Peer to Peer Network Settings for the Ad Hoc Peer to Peer Wireless Network on the Portable Media Device:

For example, the Office Action cited to King [0064] as teaching the element of claim 22 “detecting installation of a portable media device on the computing device, the portable media device containing peer to peer network settings for the ad hoc wireless network.” Applicants respectfully disagree. King [0064] teaches a processor determining whether there is a smart card in a smart card reader, in other words, detecting the installation of the smart card into the smart card reader. King [0064], however, does not teach the smart card containing network settings, as called for by claim 22. As previously discussed, the network identity and the configuration data contained on the smart card in King are the network identity and configuration data specific to the processing unit. A new, replacement entity may read the network identity and the configuration data from the smart card and incorporate as its own in order to represent itself as a working version of the specific failed unit to the rest of the network.

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

Unlike King, however, the “peer to peer network settings” of claim 22 are not particular to the computing device, but are instead particular to the ad hoc peer to peer wireless network. For example, in the portable media device of the present application, instead of storing the network identity by which the failed computing device was known to the network as in King, the name of the actual entire peer to peer network may be stored (specification, [0048]). Other such network (and not computing entity) level settings are described in [0043]-[0044] and Figure 8 of the specification. This distinction between King and the present application makes sense, as King is directed to configuring a replacement device or processor to appear as an identical replacement for a failed entity. Thus, King’s processor would need to receive from the smart card the network identity and configuration data of the failed entity in order to present itself to the network as a working replacement of the failed entity (King, [0010]). The smart card would not need (and is not taught to contain) any network settings of the network itself, as all the replacement unit would require to simulate the failed entity is the specific network identity and configuration data of the failed entity.

Additionally, the Office Action did not cite to any passages of Polcha as teaching, disclosing or suggesting this element of claim 22 “detecting installation of a portable media device on the computing device, the portable media device containing peer to peer network settings for the ad hoc wireless network,” nor was Polcha used for this purpose. Accordingly, the Office Action has not demonstrated a combination of King and Polcha that teaches the missing element.

Automatically Configuring Using Ad Hoc Peer to Peer Network Settings From Portable Media Device:

Moreover, with respect to the element of claim 22 “automatically configuring the computing device for joining the ad hoc peer to peer wireless network using the network settings contained in the portable media device,” Applicants respectfully submit that cited passages Polcha [0040] lines 1-4, King [0011] lines 1-4 and King [0001] do not teach, disclose or suggest this element. As previously discussed, King does not teach the network settings being contained in his smart card; King only teaches the network identity and

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

configuration data of a specific failed entity being contained in his smart card. Polcha [0040] lines 1-4 also does not teach “the network settings contained in the portable media device,” as Polcha [0040] lines 1-4 does not mention a portable media device at all, let alone any contents of a portable media device.

Additionally, Polcha [0040] lines 1-4 does not teach “automatically configuring the computing device...” as called for by claim 22. Cited passage Polcha [0040] lines 1-4 merely describes automatically retrieving information from a database and automatically populating input fields in dialog boxes with the information. No automatic configuration of any computing device is taught in Polcha [0040] lines 1-4. Cited passages King [0011] lines 1-4 and King [0001] also do not teach automatic configuration of a computer device, as they are general statements about a computer system having processing units connected via a communication network, and the portable storage device of King’s invention containing the processing unit identity and configuration of a processing unit. Thus, the Office Action has not demonstrated a combination of King and Polcha that teaches the missing element “automatically configuring the computing device for joining the ad hoc peer to peer wireless network using the network settings contained in the portable media device.”

For at least the above reasons, Applicants respectfully submit that the Office Action has not shown that each and every element of claim 22 is found in a combination of King and Polcha. Thus, the Office Action has not established a *prima facie* case of obviousness for independent claim 22 with King and Polcha. Accordingly, independent claim 22 is allowable over King and Polcha under 35 U.S.C. §103(a).

Claims 23-24:

Claims 23 and 24 were rejected under 35 U.S.C. §103(a) as unpatentable over King and Cedola. Claims 23 and 24 each depend from independent claim 22. With regard to independent claim 22, the Office Action, page 11 only cited to passages of King and Polcha, but not Cedola. Applicants respectfully that the Office Action has not demonstrated a *prima facie* case of obviousness for claims 23 and 24 for at least the following reasons.

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

Claims 23 and 24 each depend from independent claim 22. As previously discussed, Cedola is disqualified as a reference, and the Office Action has not demonstrated a combination of King and Polcha that teaches, suggests or discloses each and every element of independent claim 22. As each of dependent claims 23 and 24 incorporate by reference each and every element of independent claim 22, the Office Action also has not demonstrated a combination of King and Polcha that teaches, suggests or discloses each and every element of dependent claims 23 and 24. Accordingly, the Office Action has not established a *prima facie* case of obviousness for claims 23 and 24 with King and Polcha. Claims 23-24 are thus allowable over King and Polcha under 35 U.S.C. §103(a).

Claims 25 and 26:

Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as unpatentable over King, Cedola and Polcha. As previously discussed, Cedola is disqualified as a reference, thus only King and Polcha remain as allegedly qualified references. Claims 25 and 26 each depend from claim 22, which was previously shown to be allowable over King and Polcha. Accordingly, for reasons similar to independent claim 22, Applicants respectfully submit claims 25 and 26 are also allowable over King, Cedola and Polcha under 35 U.S.C. §103(a).

Claims 30 and 31:

Claims 30 and 31 were rejected under 35 U.S.C. §103(a) as unpatentable over King, Cedola and Polcha. As previously discussed, Cedola is disqualified as a reference, thus only King and Polcha remain as allegedly qualified references. Claims 30 and 31 each depend from independent claim 27 that was allegedly rejected as being unpatentable over King and Soufi. As previously discussed, no combination of King and Soufi teaches, discloses or suggests each and every element of independent claim 27. Therefore, King alone does not teach, disclose or suggest each and every element of independent claim 27. Applicants submit Polcha also does not teach, disclose or suggest the missing elements of independent claim 27, nor was Polcha used for this purpose. Accordingly, no combination of King and Polcha teaches, discloses or suggests each and every element of independent claim 27.

Amendment dated February 15, 2009

Reply to Office Action of October 15, 2008

Claims 30 and 31 each depend from independent claim 27 and therefore incorporate by reference each and every element of independent claim 27. As no combination of King and Polcha teaches, discloses or suggests each and every element of independent claim 27, no combination of King and Polcha teaches, discloses or suggests each and every element of dependent claims 30 and 31. For at least the above reasons, dependent claims 30 and 31 are thus allowable over King, Cedola and Polcha under 35 U.S.C. §103(a).

CONCLUSION

In view of the above amendment and arguments, Applicants submit the pending application is in condition for allowance and an early action so indicating is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855, under Order No. 30835/306765, from which the undersigned is authorized to draw.

Dated: February 13, 2009

Respectfully submitted,

By ____/W. J. Kramer #46,229/____
William J. Kramer
Registration No.: 46,229
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant